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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,777	06/08/2000	Vikas P. Sukhatme	1440.1023-011	1530

29933 7590 06/18/2002

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EXAMINER

DAVIS, NATALIE A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/18/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/589,777

Applicant(s)

SUKHATME, VIKAS P.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-34 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 17-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4 and 11-16 is/are allowed.
- 6) ☒ Claim(s) 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

Applicant's amendment filed 15 March 2002 (Paper No: 11) is acknowledged. Accordingly, claims 3-4 and 35 are amended, claim 1 is cancelled, claims 2-35 are pending, claims 5-10 and 17-34 are drawn to non-elected claims, claims 1-4, 11-16, and 35 are under examination.

#### ***Response to Arguments***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Specification Objection-Withdrawn***

Objection to the abstract of disclosure is withdrawn in view of amendments.

#### ***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Withdrawn***

Rejection of claims 2 and 35 under 35 U.S.C.112, second paragraph is withdrawn in view of arguments and amendments.

#### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Maintained***

Rejection of claim 35 under 35 U.S.C.112, first paragraph is maintained for reasons set forth in the previous office action. The traversal is on the grounds that EM1 derivatives can have one or more residues chemically derivatized by reaction of functional side group and provides examples of how to make such compounds. Likewise, one of ordinary skill in the art would be able to utilize the teachings in the specification to select mutants, derivative, analogs, and homologs of MM1 that retain anti-angiogenic activity. Applicant's arguments have been considered but are not persuasive because a mutant or derivative of EM1 could be any molecule derived from claim 2. The rejection may be overcome if the claim were to recite what function the molecule must possess. *enablers*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, PhD  
June 8, 2002

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600